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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,836	05/16/2001	Han Oh Park	024018/0105	9171

22428 7590 10/21/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
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WARE, DEBORAH K

ART UNIT	PAPER NUMBER
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1651

DATE MAILED: 10/21/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application N .

09/855,836

Applicant(s)

PARK ET AL.

Examiner

Deborah K. Ware

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 16-45 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-2 is/are allowed.
- 6) ☒ Claim(s) 3-5, 7-21, 14-15, 41, 46-47 is/are rejected.
- 7) ☒ Claim(s) 6 & 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

Claims 1-~~45~~ are pending.

Claims 16-45 remain withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected invention(s), there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 11.

This application contains claims 16-45 drawn to an invention nonelected with traverse in Paper No. 11. A complete reply to the final rejection must include cancelation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i). Further, it should be noted that only claims limited to the same scope of any indicated allowable subject matter can be rejoined.

Claims 1-15<sup>and 46-47</sup> are reconsidered on the merits.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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Claims 3-5, 7, 10-12 and 14<sup>and 46-47</sup> remain rejected under 35 U.S.C. 103(a) as obvious over Sawada et al., cited of record as (A) on a previously submitted PTO-892 Form, for reasons of record.

Applicants' arguments filed March 19, 2003, have been fully considered but they are not persuasive. Applicants' argument that Sawada comprises no bacteria of any sort and thus, Sawada is limited to a pharmaceutical comprising the polysaccharide complexes isolated from the bacteria, is noted. However, Sawada does clearly teach similar bacteria as claimed as being capable of producing the desired active ingredient: the extracellular polysaccharide as claimed herein. Therefore, it would have been an obvious modification of the cited prior art to use the whole bacteria capable of producing the extracellular polysaccharide as disclosed by Sawada. One of skill would have known at the time the claimed invention was filed and would have been motivated to select whole bacteria capable of producing the polysaccharide for pharmaceutical use. Thus, these claims remain obvious over Sawada.

Claims 3-5, 7-12 and 14-15<sup>and 46-47</sup> remain rejected under 35 U.S.C. 103(a) as being unpatentable over Sawada et al in view of Becker et al and if necessary in further view of Toyosaki et al, (all cited of record) for reasons of record.

Applicant's arguments filed March 19, 2003, have been fully considered but they are not persuasive. In response to applicant's argument that none of the references teach using the whole bacteria in the pharmaceuticals, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would

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otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). It should be noted that polysaccharides of cell walls is an extraceullular polysaccharide. Sawada teaches such extracellular polysaccharides at col. 2, lines 25-35. Further, the argument that *Acetobacter* strains of Toyosaki are different than the strain of *Acetobacter* BC-Y058 is noted, however, the claims under rejection herein are not so limited to the specific strain. One of skill would have been motivated to select from any whole microorganism whether those of Sawada or Toyosaki to provide for the desired active ingredient of which is an extracellular polysaccharide. Cellulose is an extracellular polysaccharide whether it is produced in a culture or in a jar. Sawada clearly teaches the desire to use these in a pharmaceutical as does Becker. The claims remain prima facie obvious over the cited prior art because they are taught, or at least suggested, by the combination of prior art references noted above and cited of record.

Claims 1-2 are allowable.

Claims 6 and 13 are free of the prior art but are objected to for being dependent upon rejected base claims.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah K. Ware whose telephone number is 308-4245. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Wityshyn can be reached on 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-0196.



Deborah K. Ware  
October 18, 2003



DAVID M. NAFF  
PRIMARY EXAMINER  
ART UNIT 1651